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MAILED
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OFFICE OF PETITIONS

In re Patent of	:	
ARIE DEGABLI	:	
Patent No.: 6,367,154	:	
Issue Date: 04/09/2002	:	
Application No. 09/270151	:	
Filing or 371(c) Date: 03/16/1999	:	ON PETITION
Title of Invention:	:	
COMBINATION UTILITY KNIFE	:	

This is a decision on the petition under 37 CFR § 1.378(e), filed August 30, 2012, and supplemented with the petition fee on September 10, 2012, requesting reconsideration of a decision dismissing a petition to reinstate the above-identified patent.

The petition is **DENIED**.

This decision is a final agency action within the meaning of 5 U.S.C. §704 for purposes of seeking judicial review.

Background

The patent issued April 9, 2002. Patentee could have paid the seven and one half (7½) year maintenance fee between April 9, 2009, and October 9, 2009, without a surcharge, or within the six (6) month grace period between October 10, 2009 and April 9, 2010. Patentee failed to do so; accordingly, the patent became expired on April 10, 2010.

The April 18, 2012 petition

Petitioner/Patentee filed a present petition to reinstate the above-identified patent on April 18, 2012, wherein patentee provided that payment of the seven and one half (7½) year maintenance fee was unavoidably delayed because the address that was on file with this Office changed sometime in 2005. Patentee provided further that a forwarding mail request was in place but it had expired.

June 4, 2012 Decision dismissing petition

The petition was dismissed in a Decision mailed June 4, 2012. The Decision dismissing the petition noted that Patentee was unaware of the need to pay the maintenance fee and had not

demonstrated that any steps were taken to ensure timely payment of the maintenance fee, and informed Patentee that the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminders does not constitute unavoidable delay.

The Decision noted further that it is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. In this instance, Patentee provided only that payment of the seven and one half ($7\frac{1}{2}$) year maintenance fee was unavoidably delayed because the address that was on file with this Office changed sometime in 2005. The Decision informed Patentee that where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) precluded acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

The present renewed petition

Petitioner/Patentee files the present renewed petition and provides that ignorance may provide a finding of unavoidable delay; but that the ignorance excuse requires the unrepresented patent holder make some effort to inform himself of the legal obligations associated with owning a patent. Patentee also avers that complete ignorance of the fact that a patent exists can also create an avoidable excuse.

Petitioner, however, admits that they do not have any proof of this since it goes so far back but this was really human error, and concludes that it was unavoidable.

Applicable Law, Rules and MPEP

Petition to reinstate under 37 CFR 1.378(b)

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
- (B) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (C) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The applicable law requires a showing that the delay in paying the maintenance fee was unavoidable despite reasonable care being taken to ensure that the maintenance fee would be timely paid. The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. (Emphasis supplied).

As language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., “unavoidable” delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. *See Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting *In re Patent No. 4,409,763*, 7 USPQ2d 1798, 1800 (Comm’r Pat. 1988), *aff’d sub nom. Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff’d*, 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992)). *See* MPEP § 711.03(c) for a general discussion of the “unavoidable” delay standard.

Because 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. *Ray*, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. *Id.* Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee’s lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. *See Patent No. 4,409,763*, *supra*. *See also* Final Rule entitled “*Final Rules for Patent Maintenance Fees*,” published in the *Federal Register* at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the *Official Gazette* at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee’s agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

Moreover, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. *Link v. Wabash*, 370 U.S. 626, 633-34 (1962); *Huston v. Ladner*, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); *see also Haines v. Quigg*, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner’s delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). *Haines v. Quigg*, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891

Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552; 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Opinion

35 U.S.C. § 41(c)(1) authorizes the Director to accept a delayed maintenance fee payment "if the delay is shown to the satisfaction of the Director to have been unintentional." 35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was unintentional, but only an explanation as to why petitioner has failed to carry the burden to establish that the delay was unintentional. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F. 2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960) (35 U.S.C. § 133 does not require the Director to affirmatively find that the delay was unavoidable, but only to explain why applicant's petition was unavailing); See, also, In re Application of G, 11 USPQ2d 1378, 1380 (comm'r Pat. 1989) (petition under 37 CFR 1.137(b) denied because the applicant failed to carry burden of proof to establish that the delay was unintentional).

Petitioner/Patentee has failed to carry its burden of proof to establish to the satisfaction of the Director that the delay in payment of the first maintenance fee was unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(c).

Petitioner's original petition filed April 18, 2012 averred that payment of the seven and one half (7½) year maintenance fee was unavoidably delayed because the address that was on file with this Office changed sometime in 2005. Patentee provided that a forwarding mail request was in place but it had expired.

Petitioner's renewed petition asserts that ignorance may provide a finding of unavoidable delay, but that the ignorance excuse requires the unrepresented patent holder make some effort to inform himself of the legal obligations associated with owning a patent. Patentee also avers that complete ignorance of the fact that a patent exists can also create an avoidable excuse.

Petitioner admits, however, that they do not have any proof of this since it goes so far back but this was really human error, and concludes that it was unavoidable.

This decision reiterates that the law requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Here, Patentee was unaware of the need to pay the maintenance fee and is unable to demonstrate that any steps were taken to ensure timely payment of the maintenance fee. Moreover, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminders does not constitute unavoidable delay.

Further to this, as stated above, it is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. Here, Patentee provides that payment of the seven and one half (7½) year maintenance fee was unavoidably delayed because the address that was on file with this Office changed sometime in 2005. Patentee on renewed petition provides only that this was human error. It is reiterated that where the record fails to

disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

Conclusion

Petitioner's arguments have been considered; however, Petitioner has failed to demonstrate that the failure to pay the maintenance fee was unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).

Decision

The instant petition under 37 CFR 1.378(e) is granted to the extent that the decision of June 4, 2012 has been reconsidered; however, the renewed petition to accept under 37 CFR 1.378(e) the delayed payment of a maintenance fee and reinstate the above-identified patent is **DENIED**.

This patent file is being forwarded to the Files Repository.

Telephone inquiries concerning this matter should be directed to Attorney Derek L. Woods at (571) 272-3232.


Anthony Knight
Director
Office of Petitions